

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICANT: | CHARLES H. LENORE ET AL |) | |
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| SERIAL NO.: | 10/020,616 |) | ART UNIT |
| | |) | 3629 |
| FILED: | December 13, 2001 |) | |
| | |) | EXAMINER: |
| FOR: | METHOD, SYSTEM AND STORAGE |) | Mooneyham, |
| | MEDIUM FOR MANAGING AND |) | Janice A. |
| | PROVIDING ACCESS TO LEGAL |) | |
| | INFORMATION |) | |

MS Appeal Brief - Patents
Commissioner for Patents
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APPEAL BRIEF

I. REAL PARTY IN INTEREST

The real party in interest is Charles H. Lenore, and Robert A Brooks.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals pending.

III. STATUS OF CLAIMS

Claims 1-46 stand finally rejected.

The rejections of claims 1-46 are herein appealed.

IV. STATUS OF AMENDMENTS

There have been no amendments filed after the final rejection mailed May 4, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal is provided below.

Claim 1 is directed to a method for managing legal information related to at least one legal matter in a system including a legal enterprise 10 and a storage system 20 coupled through a network 6, as shown in Figure 1 and discussed on page 5, lines 5-21 in the specification. When a user contacts the storage system 20, the user is prompted for a user identification and password. Through user identification and password, the storage system 20 controls the level of interaction with legal information stored in database 24. Designated personnel of legal enterprise 10 have the discretion to set levels of access for all users, or subgroups of users. Contributors of legal information (e.g., personnel such as attorneys or paralegals of the legal enterprise 10) may submit or edit legal information as well as view existing legal information. Clients may view legal information, but generally cannot contribute or edit legal information. A user is identified as a contributor or a client through the user identification and password. In addition, access to legal information is limited on a matter-by-matter basis. A client can only view legal information for matters involving that client. Similarly, personnel with the legal enterprise may be limited to accessing legal information on only those matters with which the personnel is involved. Storage system 20 enforces the limits on access by requiring users to submit user identifications and passwords. The legal information includes an evidentiary outline corresponding to one of the legal matters, and further includes a party's position and a link to evidence stored in the database supporting the party's position. The link is created by a contributor having authority to modify legal information in the database.

Claim 16 is directed to a system for managing legal information related to at least one legal matter, as discussed on page 5, lines 5-24, page 6 lines 1-24, and page 7 lines 1-4 in the specification. The system includes the storage system 20 for receiving legal information from a contributor at the storage system 20 via the network 6. The system further includes a database 24 associated with the storage system for storing the legal information. A user can send a request to the storage system 20 to access legal information, which can be performed

over the network 6. The legal information can include an evidentiary outline corresponding to one of the legal matters, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position.

Claim 33 is directed to a storage medium encoded with machine-readable computer program code for managing legal information related to a legal matters in a system including a legal enterprise 10 and a storage system 20 coupled via a network 6, as discussed on page 5, lines 22-24, page 6 lines 1-24, and page 7 lines 1-4 in the specification. The storage medium includes instructions for causing the storage system to implement a method including receiving legal information from a contributor at the storage system 20 via the network 6, storing the legal information in a database 24 associated with the storage system 20, receiving a request to access legal information from a user via the network 6 and providing the legal information to the user via the network 6.

The above exemplary embodiments are discussed with respect to the aforementioned independent claims by way of example only and are not intended to in any way limit the scope of these claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4, 16-19, and 30-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krachman (US 6,738,760) in view of Simpson et al (US 6,549,894) (hereinafter Simpson). Claims 5-15, 20-28, and 37-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krachman in view of Simpson as applied to Claims 1, 16 and 33 above, and further in view of Embracing the Virtual Office Concept: How Legal Anywhere Collaborator! Can Help, By David H. Griggs published February 2000 (hereinafter Griggs).

VII. ARGUMENT

Claims 1-4, 16-19, and 30-36 are Non-Obvious Krachman and Simpson

Applicants respectfully assert that the rejection is improper because the Final Office Action has failed to establish a Prima Facie case of obviousness. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

As now discussed, all of the elements of Applicants' claimed invention are not found in the prior art. Claim 1 recites "the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database." In embodiments of the invention, the information in the database evidence supporting a party's position is inserted into the database and linked to by a contributor as described in at least page 7, lines 5-20 of Applicants' specification. Krachman fails to teach or suggest this feature. In Krachman, AI is used to search documents based on a query. The search results are presented to the user as a series of links to documents as shown in Figure 10 of Krachman. Krachman, however, does not teach that links are created in the database between a party's position and evidence supporting that position. Furthermore, the Final Office Action states that in Figure 1, label 11 is Applicants' "evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position." In addition, in the Final Office Action's Response to Applicant's Arguments, the Final Office Action maintains the position that "Krachman discloses case name, lawyer's summary, pleadings, proof of fact, fact chronologies/issues, investigation reports, deposition transcripts etc." These assertions of the Final Office Action are incorrect. Applicants respond by asserting that the

aforementioned list is a field for search criteria input by the user, and not a link between an evidentiary outline and the actual supporting evidence itself, as in Applicants' claimed invention. More specifically, label 11 refers to "fields needed to create and train a neural network, such as Dynamic Reasoning Engine (DRE) available from Autonomy, Inc.,...using AI." (Col. 3, lines 33-36). Therefore Krachman's field 11 is simply an input for search criteria. As such, Applicants assert that Krachman teaches a search engine that relies on the training of neural networks to access search results, which is in clear contrast to Applicants' claimed invention that teaches, among other things, "storing legal information in a database associated with the storage system, said legal information including an evidentiary outline corresponding to said legal matter, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database."

Furthermore, the Final Office Action has cited a section of Simpson that discloses "a computerized docketing system for legal matters (col. 3, lines 36-47) wherein only authorized users are allowed to access and wherein some users are given full read/write ability whereas others are given only read ability (col. 5, lines 36-48) and links to electronic intellectual property forms (col. 5, lines 26-27). The cited section of Simpson provides no teaching or suggestion of Applicants' "link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database." Simpson merely discloses an access feature to the Simpson database and not authority to modify legal information in the database of Applicant's claimed invention. Furthermore, Simpson's link is simply to forms. In contrast, Applicants' link is to "evidence stored in the database supporting the party's position" (from the evidentiary outline).

Thus, Krachman in view of Simpson fails to teach the elements of Claim 1, provide any teaching or suggestion for the modification, and has no reasonable expectation of success.

For at least the above reasons, Claim 1 is patentable over Krachman in view of Simpson. Claims 16 and 33 recite similar features as Claim 1 and are patentable over Krachman in view of Simpson for at least the reasons advanced with reference to Claim 1. Claims 2-4 depend from Claim 1, Claims 17-19 and 30-32 depend from Claim 16, and Claims 34-36 depend from Claim 33, and are patentable over Krachman in view of Simpson for at least the reasons advanced with reference to Claim 1.

Claims 5-15, 20-28 and 37-46 Are Non-Obvious Over Krachman, Simpson and Griggs

Applicants respectfully assert that the rejection is improper because the Final Office Action has failed to establish a Prima Facie case of obviousness. As now discussed, all of the elements of Applicants' claimed invention are not found in the prior art. Griggs was relied upon for disclosing different access rights for clients and contributors, but fails to cure the deficiencies of Krachman in view of Simpson discussed above with reference to Claim 1. In general, Applicants respectfully assert that Griggs is nothing more than marketing literature that provides no support or enablement for the product in which Griggs is marketing.

The Final Office Action has cited a section of Griggs that states that "Collaborator permits you to grant editing rights". The cited section of Griggs provides no teaching or suggestion of Applicants' "link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database." Griggs merely makes a marketing assertion that editing grants can be granted to certain parties (clients, co-counsel, colleagues), but makes no disclosure related to "authority to modify legal information in the database", the authority being the creation of "a link to evidence stored in the database storing the party's position" of Applicant's claimed invention. With regard specifically to Claims 9, 24, and 41, the Final Office Action asserts that page 3 of Griggs provides Applicants' "wherein the legal information is encrypted prior to transmission to the storage system." Applicant respectfully asserts that Griggs specifically *does not* provide Applicants' subject matter of Claims 9, 24, 41. Rather Griggs states "is as

secure as the most current encryption levels allow.” Once again, this is a fluffed marketing claim and *does not* state that “legal information is encrypted prior to transmission to the storage system.” Griggs merely analogizes that the Griggs solution is *like* the security provided by encryption.


Claims 5-15 depend from Claim 1 and are patentable over Krachman in view of Simpson and Griggs for at least the reasons advance with reference to Claim 1. Claims 20-28 depend from Claim 16 and are patentable over Krachman in view of Simpson and Griggs for at least the reasons advance with reference to Claim 16. Claims 37-46 depend from Claim 33 and are patentable over Krachman in view of Simpson and Griggs for at least the reasons advance with reference to Claim 33.

In summary, Claims 1-46 are non-obvious over the art of record. For the reasons cited above, Appellants respectfully submit that all of the claims are allowable and the application is in condition for allowance. Appellants respectfully request reversal of the outstanding rejections of Claims 1-46 and allowance of this application.

In the event the Examiner has any queries regarding the submitted arguments, the undersigned respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

If there are any charges with respect to this Appeal Brief or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. (Previously Presented) A method for managing legal information related to at least one legal matter in a system including a legal enterprise and a storage system coupled via a network, the method comprising:

storing legal information in a database associated with the storage system, said legal information including an evidentiary outline corresponding to said legal matter, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database; and,

providing the legal information to a client via the network.

2. (Previously Presented) The method of claim 1 further comprising determining if a user is a client having authority to view legal information in the database or the contributor having authority to modify legal information in the database.

3. (Original) The method of claim 2 wherein said determining is based on a user identification and password.

4. (Original) The method of claim 2 further comprising enabling the contributor to add a further link to further evidence in the database.

5. (Original) The method of claim 2 further comprising enabling the contributor to edit the link to the evidence in the database.

6. (Original) The method of claim 2 wherein if the user is determined to be a client, said providing legal information is restricted to legal information associated with that client.
7. (Original) The method of claim 2 wherein the contributor has access to legal information related to all said plurality of legal matters.
8. (Original) The method of claim 2 wherein the contributor has access to legal information related to a subset of all said plurality of legal matters.
9. (Original) The method of claim 1 wherein the legal information is encrypted prior to transmission to the storage system.
10. (Original) The method of claim 1 wherein said evidence includes documents produced through discovery.
11. (Original) The method of claim 1 wherein said evidence includes responses to interrogatories.
12. (Original) The method of claim 1 wherein said evidence includes deposition transcripts.

13. (Original) The method of claim 1 wherein said evidence includes an audio file.
14. (Original) The method of claim 1 wherein said evidence includes a video file.
15. (Original) The method of claim 1 wherein said evidentiary outline includes multiple parties' positions.
16. (Previously Presented) A system for managing legal information related to at least one legal matter, the system comprising:
- a storage system for receiving legal information from a contributor at the storage system via a network;
 - a database associated with the storage system for storing the legal information;
 - said storage system receiving a request to access legal information from a user via the network;
 - said storage system providing the legal information to the user via the network;
 - said legal information including an evidentiary outline corresponding to one of said legal matters, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database.
17. (Previously Presented) The system of claim 16 wherein the storage system determines if a user is a client having authority to view legal information in the database or the contributor having authority to modify legal information in the database.

18. (Original) The system of claim 17 wherein said determining is based on a user identification and password.
19. (Original) The system of claim 18 further comprising enabling the contributor to add a further link to further evidence in the database.
20. (Original) The system of claim 17 further comprising enabling the contributor to edit the link to the evidence in the database.
21. (Original) The system of claim 17 wherein if the user is determined to be a client, said providing legal information is restricted to legal information associated with that client.
22. (Original) The system of claim 17 wherein the contributor has access to legal information related to all said plurality of legal matters.
23. (Original) The system of claim 17 wherein the contributor has access to legal information related to a subset of all said plurality of legal matters.
24. (Original) The system of claim 16 wherein the legal information is encrypted prior to transmission to the storage system.

25. (Original) The system of claim 16 wherein said evidence includes documents produced through discovery.

26. (Original) The system of claim 16 wherein said evidence includes responses to interrogatories.

27. (Original) The system of claim 16 wherein said evidence includes deposition transcripts.

28. (Original) The system of claim 17 wherein said evidence includes an audio file.

29. (Original) The system of claim 16 wherein said evidence includes a video file.

30. (Original) The system of claim 16 further comprising a legal enterprise system coupled to the network, said legal enterprise system producing said legal information.

31. (Original) The system of claim 30 further comprising a remote system coupled to the network, the remote system producing the request to access legal information and receiving the legal information via the network.

32. (Original) The system of claim 31 wherein the remote system corresponds to a client.

33. (Previously Presented) A storage medium encoded with machine-readable computer program code for managing legal information related to a plurality of legal matters in a system including a legal enterprise and a storage system coupled via a network, the storage medium including instructions for causing the storage system to implement a method comprising:

receiving legal information from a contributor at the storage system via the network;
storing the legal information in a database associated with the storage system;

receiving a request to access legal information from a user via the network; and,

providing the legal information to the user via the network;

said legal information including an evidentiary outline corresponding to one of said legal matters, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position, the link created by a contributor having authority to modify legal information in the database.

34. (Previously Presented) The storage medium of claim 33 further comprising instructions for causing the storage system to determine if a user is a client having authority to view legal information in the database or the contributor having authority to modify legal information in the database.

35. (Original) The storage medium of claim 34 wherein said determining is based on a user identification and password.

36. (Original) The storage medium of claim 34 further comprising instructions for causing the storage system to enable the contributor to add a further link to further evidence in the database.

37. (Original) The storage medium of claim 34 further comprising instructions for causing the storage system to enable the contributor to edit the link to the evidence in the database.

38. (Original) The storage medium of claim 34 wherein if the user is determined to be a client, said providing legal information is restricted to legal information associated with that client.

39. (Original) The storage medium of claim 34 wherein the contributor has access to legal information related to all said plurality of legal matters.

40. (Original) The storage medium of claim 34 wherein the contributor has access to legal information related to a subset of all said plurality of legal matters.

41. (Original) The storage medium of claim 33 wherein the legal information is encrypted prior to transmission to the storage system.

42. (Original) The storage medium of claim 33 wherein said evidence includes documents produced through discovery.

43. (Original) The storage medium of claim 33 wherein said evidence includes responses to interrogatories.

44. (Original) The storage medium of claim 33 wherein said evidence includes deposition transcripts.

45. (Original) The storage medium of claim 33 wherein said evidence includes an audio file.

46. (Original) The storage medium of claim 33 wherein said evidence includes a video file.

IX. EVIDENCE APPENDIX

There is no evidence submitted pursuant to 37 C.F.R. §1.130, 37 C.F.R. §1.131, or 37 C.F.R. §1.132 or any other evidence entered by the Examiner and relied upon by the Appellant in this appeal, known to the Appellants, Appellants' legal representatives, or assignee.

X. RELATED PROCEEDINGS APPENDIX

There are no other related appeals or interferences known to Appellants, Appellants' legal representatives, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.